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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,081	03/01/2002	Takayuki Yamamoto	220119US0	9114

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

UHLIR, NIKOLAS J

ART UNIT PAPER NUMBER

1773

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/085,081

Applicant(s)

YAMAMOTO ET AL.

Examiner

Nikolas J. Uhler

Art Unit

1773

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 December 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-4, 6, 8-11.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of box 5(c):

The examiner has carefully considered the declaration and request for reconsideration dated 12/22/03 and finds them to be unpersuasive.

First, regarding applicant's declaration and argument of unexpected results. The examiner acknowledges that the samples labeled sample4-6% and sample4-10% exhibit better corrosion resistance than the other examples in the declaration. However, these samples utilize aluminum phosphomolybdate as a rust inhibitor in addition to zinc powder. Applicant's showing is not commensurate in scope with the claims because the claims are not limited to any specific type of rust inhibitor. As a result, applicants showing is unpersuasive because it does not establish that other rust inhibitors more basic than zinc (i.e. the zinc molybdate used in Shinohara) do not attain the same results.

Applicant has also argued that it is the combination of zinc powder and rust inhibitor that enables the instant invention to obtain unexpectedly improved corrosion resistance. The rust inhibitor is Shinohara is merely an optional additive and Shinohara does not disclose a suitable range amount of rust inhibitor and its synergistic effect with the zinc powder.

The examiner finds this argument unpersuasive. In each of Shinohara's specific examples, a rust inhibiting agent that meets applicants claim requirements is utilized in combination with zinc powder (see table 1). Although the specific examples of Shinohara have lower quantities of Zn powder, Shinohara specifically teaches that 15-70% by weight of Zn powder can be utilized (see page 4, lines 1-16). Further, on page

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4, lines 1-16, Shinohara teaches that the paint can contain 15-70 wt% Zn powder and 20-50% pigment, wherein the pigment can be a rust inhibiting pigment. Thus, Shinohara *clearly* suggests the combination of Zinc powder and rust inhibitor.

The applicant has argued specifically against the rejection of claim 6, asserting that the combination of Wasel-Nielen with Shinohara does not teach the required average particle size. The applicant further argues that the claimed particle size unexpectedly improves the corrosion resistance, as shown by table 1 in the specification. First, the applicants showing in Table 1 is inconclusive at best, as the improved corrosion resistance in sample 9 (as compared to samples 12-13) could simply be arising from the fact that sample 9 utilizes 10.3% rust inhibitor whereas samples 12 and 13 utilize only 6.52% and 5.83% rust inhibitor respectfully. Second, The examiner agrees that Wasel-Nielen does not explicitly teach the specific particle size required by claim 6. However, Wasel-Nielen does teach that rust inhibiting pigments having a 90% of the particles with a diameter in the range of 0.05-8 μ are particularly suited for use as rust inhibiting pigments (column 4, lines 26-41 and column 6, example 6) and that the particle size the anticorrosive pigment is preferably small, so that the pigment can exhibit maximum surface area and coverage with a minimum amount of pigment utilized. In lieu of this teaching, the examiner maintains that it would have been within the realm of one of ordinary skill in the art at the time the invention was made to control the particle size of the rust inhibiting pigment taught by the primary reference to applicants claimed range.

NSM

Paul Thibodeau
Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700